

REMARKS

Claims 1-14 have been examined. With this amendment, Applicant cancels claim 5.

Claims 1-4 and 6-14 are all the claims pending in the application.

I. Formalities

The Examiner contends that the priority document for this application was not received. Applicant's records indicate that the priority document, JP 2000-139117, was submitted in the original filing of May 3, 2001. A copy of the date stamped receipt is attached for the Examiner's convenience. In addition, a copy of the Image File Wrapper page on the PTO Website is attached which indicates a 22 page Foreign Priority Document was submitted on May 3, 2001.

Applicant requests that the Examiner acknowledge receipt of the priority document in the next Office Action.

II. Claim Rejections - 35 U.S.C. § 112

1) The Examiner has rejected claim 1 under 35 U.S.C. § 112, second paragraph, as being indefinite. The Examiner states that it is an improper method claim [no positively recited method step].

Applicant submits that the modifications to claim 1 obviate the rejection. In addition, Applicant notes that claim 1 is not a method claim.

2) The Examiner has rejected claim 2 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Examiner has also rejected claim 2 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

**Amendment Under 37 C.F.R. § 1.111
U.S. Serial No. 09/847,443**

Attorney Docket No.: Q64369

AMENDMENTS TO THE DRAWINGS

Applicant is submitting one replacement drawing sheet including FIG 3. Applicant has added reference character 30 to identify the second network connecting terminal 14 and server 15.

Attachment: One Replacement Sheet

Applicant has modified claim 2 for clarity and precision of language. Applicant submits that the modification is supported at least at page 5, lines 9-12 of the specification and obviate the rejections.

3) The Examiner has rejected claims 8 and 11 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Examiner has also rejected claims 8 and 11 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. Specifically, the Examiner contends that there are no first network and second network as claimed by the Applicant according to Fig. 3 and corresponding pages of the specification.

Applicant submits that the specification fully supports the use of a second network. At page 9, line 27 to page 10, line 2, the original specification states “ the line between the user terminal 14 and the address server 15 need not to be a telephone line, nor a packet line, but may be the Internet for convenience.” Since the Internet would commonly be considered a network by one skilled in the art, Applicant submits that the original specification fully supports and enables one skilled in the art to practice the invention as set forth in claims 8 and 10.

Applicant notes that the above quoted section and FIG 3 have been modified to include a reference number for the line between user terminal 14 and the address server 15.

4) The Examiner has rejected claim 14 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Examiner has also rejected claim 14 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. Specifically, the Examiner contends that the recitation “wherein if the inquiring of the address

server about the address corresponding to the name of the computer on the terminating side returns an Internet Protocol (IP) address, then the communication with the terminating side computer is in IP mode” is not supported by the specification.

The specification describes a non-limiting embodiment of the invention in which a user stores a homepage on a computer with an address that uses a number, e.g. a telephone number or an ISDN number (page 6, lines 22-27). The homepage is registered in a server that performs a function similar to a DNS server of the Internet (page 7, lines 7-10). Since the server may be connected to the Internet (page 9, lines 1-2), a second user can then use a search engine on the Internet to obtain the name of the homepage (page 7, lines 11-15). If the search engine returns a homepage with an address that has a number, i.e., a telephone number or an ISDN number, the second user can then use his computer to establish communications with the homepage of the first user using a telephone network (page 7, lines 16-22). Implicit in this disclosure is the simple fact that if the homepage has the conventional Internet address, i.e., the Internet Protocol (IP) address, the communication with between the second user and the homepage of the first user will take place in the conventional manner, i.e., IP mode. Accordingly, Applicant submits that the specification fully supports and enables the features recited in claim 14.

5) The Examiner has rejected claim 12 for reciting the limitation “the apparatus” in line 1 because there is insufficient antecedent basis for this limitation in the claim. Similarly, the Examiner has rejected claim 13 for reciting the limitation “the method” in line 1 because there is insufficient antecedent basis for this limitation in the claim.

Applicant submits that the modifications to these claims obviate the objections.

III. Specification and Drawings

Applicant has modified the specification and Fig. 3 to include a reference numeral to the line between terminal 14 and server 15. No new matter has been added.

IV. Claim Rejections - 35 USC § 102

The Examiner has rejected claims 1-5, 7-8, 11 and 14 under 35 U.S.C. § 102(e) as being anticipated by Sabatier *et al.* (US 6,754,708) ["Sabatier"]. For at least the following reasons, Applicant traverses the rejection.

Claim 1 recites a computer communication network that comprises "a first computer identified by an address recognizable by a telephone network when the first computer connects to the telephone network; a second computer identified by an address recognizable by the telephone network when the second computer connects to the telephone network; and an address server for correlatively storing addresses, which include the addresses recognizable by the telephone network, and names corresponding to the addresses, wherein the first computer is configured to request from the address server an address by transmitting a name of the second computer, and is configured to communicate with the second computer using the address received from the address server."

The Examiner contends that the claimed features are disclosed by citing sections of Sabatier but does not provide any reasoning in his rejection as is required by the MPEP. See MPEP at 2100-22 ("The Office action should clearly communicate the findings, conclusions and reasons which support them.").

As best understood by Applicant, based on the cited sections, the Examiner is contending that terminals 1, 2 and telephone numbers N1, N2 correspond to the claimed computers and the

addresses recognizable by the telephone network, respectively. The server 5 allegedly corresponds the claimed address server, and the IP addresses stored by server 5 allegedly correspond to the claimed stored addresses. Finally, Applicant understands that the Examiner is contending that the company names in directory 54 correspond to the claimed names.

Sabatier discloses that terminals 1 and 2 connect to the server 5 in order to communicate over the Internet using IP addresses (col. 3, line 50 to col. 4, line 3). The server 5 uses the telephone number N1, N2 of the terminals to associate the terminals with their respective IP addresses and stores the telephone numbers, IP addresses and any other attributes (such as company names) in directory 54 (col. 3, lines 21-26 and lines 50-64). Sabatier also discloses that terminal 1 transmits the telephone number N2 of terminal 2 to server 5 in order to receive terminal 2's IP address for establishing communications.

Therefore, Applicant submits that the company names are not transmitted for requesting the address of terminal 2, but the names merely are optional additional information. Accordingly, Sabatier does not disclose or even remotely suggest configuring a computer "to request from the address server an address by transmitting a name of the second computer" as set forth in claim 1.

To the extent the Examiner may be contending that the telephone numbers N1, N2 correspond to the claimed names, Applicant submits that the telephone numbers N1, N2 cannot correspond to both the claimed names and the claimed addresses recognizable by the telephone network. To meet the claimed features, the telephone numbers N1, N2 would have to correspond

to the claimed addresses recognizable by a telephone network since the IP addresses disclosed in Sabatier are not recognizable by the telephone network.

Accordingly, Sabatier does not disclose or suggest at least the claimed names as set forth in claim 1.

Because claims 2-4, 7 and 14 depend on claim 1, Applicant submits that these claims are patentable at least by virtue of their dependency. Claim 5 has been canceled.

Claim 8 recites a method of communications on a computer network that comprises “communicating with the server from the first computer to initially determine the address of the at least one second computer by communicating on the second network; and connecting to the at least one second computer on the first network using the address of the at least one second computer provided by the server, wherein the first network is a telephone network.” The Examiner contends that network 4 is the claimed first network and network 3 is the claimed second network. The Examiner contends that the claimed communication between the first computer and server and the claimed communication between the first computer and the second computer are disclosed. Applicant disagrees.

In order for Sabatier to disclose the claimed features, a first terminal in Sabatier would have to initially communicate with the server on the Internet 3 to get the address of a second terminal before the terminals communicate with each other on telephone network 4. Contrary to the Examiner’s contentions, Applicant submits that Sabatier discloses the opposite. The cited sections disclose a system where terminals 1 and 2 first communicate over a telephone network 4 to request communications over Internet 3 (col. 3, lines 50-52). Then, the terminals connect to a

server 5 to transmit IP addresses, which then permits the terminals to communicate over the Internet 3 (col. 3, line 50 to col. 4, line 3).

Sabatier does not disclose or suggest that a terminal initially connect to a server on a second network to receive the address of another terminal in order to communicate over a telephone network. In fact, this feature is not needed since the terminals in Sabatier already know the telephone number of the other before any communication takes place. Accordingly, Sabatier does not disclose or suggest at least the claimed communication between the first computer and the server.

Because independent claim 10 recites features similar to those given above with respect to claim 8, Applicant submits that claim 10 is patentable for at least reasons similar to those given above with respect to claim 8.

V. Claim Rejections - 35 USC § 103

The Examiner has rejected claim 6 under 35 U.S.C. § 103(a) as being unpatentable over Sabatier in view of Szutu (US Pub. 2001/0047395) ["Szutu"]. For at least the following reasons, Applicant traverses the rejection.

As best understood by Applicant, the Examiner is contending that one skilled in the art would replace the company names, which the Examiner concedes may not be unique, with the network-independent domain names of Szutu because it would provide a unique way of identifying Internet web resources. Applicant disagrees.

Sabatier discloses a system of communications between terminals using the Internet instead of telephone lines (Abstract). However, the "unique way of identifying Internet web

resources” as disclosed by Szutu does not provide a motivating factor for one skilled in the art to combine the references since the telephone number of the destination terminals is all that is needed by the invention in Sabatier to initiate communications. Since the telephone number is already unique, another system to provide a unique method of identification is not needed to identify the destination terminal (web resource). Accordingly, the Examiner’s proffered reason is not supported in the prior art.

In addition, because communication between terminals (parties) on the Internet is after an initial communication on the telephone network (Abstract), the parties involved would already know each other. Accordingly, a terminal’s company name on server 5 need not be unique since a user seeing, for example, “Company XYZ” would immediately identify the other party even if other “Company XYZs” may exist. Therefore, Applicant submits that one skilled in the art would not have been motivated to modify the system in Sabatier to have unique company names since such a system modification would not provide any tangible benefits.

Further, because Szutu does not cure the deficient teachings of Sabatier with respect to claim 1, Applicant submits that claims 6 is patentable at least by virtue of its dependency.

The Examiner has rejected claims 9, 10, 12 and 13 under 35 U.S.C. § 103(a) as being unpatentable over Sabatier in view of Yablon (US 5,764,731) [“Yablon”]. For at least the following reasons, Applicant traverses the rejection.

Because Yablon does not cure the deficient teachings of Sabatier with respect to claims 8 and 11, Applicant submits that claims 9, 10, 12 and 13 are patentable at least by virtue of their respective dependencies.

In addition, the invention in Sabatier relates to communications over the Internet 3 (the alleged claimed second network) after initial communications over telephone network 4 (the alleged claimed first network) that invite communications over the Internet (Abstract). Server 5 is needed to provide IP addresses, some of which would be provisional (temporary), for the communicating terminals (col. 4, lines 4-11).

Accordingly, Applicants submits that Sabatier cannot be modified to eliminate the server in subsequent communications between terminals as contended by the Examiner since the temporary IP addresses retained by the terminal after the initial communications with the other terminal would no longer be valid in subsequent communications. Accordingly, a new connection to the server would be required to obtain a new IP address. In fact, Applicant submits that eliminating the sever in subsequent connections would render the invention in Sabatier inoperable since the provisional IP addresses would be unassigned or assigned to other devices. Therefore, Applicant submits that the Examiner has not made a *prima facie* case of obviousness with respect to claims 9 and 12. See MPEP at 2100-131 (Proposed modifications cannot render the prior art unsatisfactory for its intended purpose).

In addition, the primary purpose of the invention in Sabatier is to use the Internet (the alleged claimed second network) (Abstract). To modify the invention in Sabatier to eliminate the Internet would be to change the principle of operation. In fact, Applicant submits that using the Internet in place of traditional telephone communications is the invention in Sabatier. Therefore, the Examiner has not made a *prima facie* case of obviousness with respect to claims

10 and 13. See MPEP at 2100-132 (Proposed modification cannot change the principle of operation of a reference).

VI. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.


Respectfully submitted,

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Inventor: Os HIYOSHI

Title: COMPUTER COMMUNICATION NETWORK

Atty Doc. #: Q64369 Client: YAMASHITA & ASSOCIATES

Filing Date: May 3, 2001 # Pgs. Spec/Abst: 14/1 #Claims: 7

Dwg. Sheets: 3 Decl YES Prelim Amdt NO

IDS/Prior Art: NO Pr Doc: YES Asgmt: YES Fee: \$710.00/\$40.00

2 Checks Attached ☐ Charge to Deposit # 19-4880 Atty/Sec: JFO/sds

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09/847,443 Computer communication network

Application Data	Transaction History	Image File Wrapper	Foreign Priority	Published Documents	Publication Dates	Address & Attorney/Agent
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02-24-2005	Non-Final Rejection	
02-24-2005	<u>List of references cited by examiner</u>	
02-24-2005	Index of Claims	
02-24-2005	<u>Search information including classification, databases and other search related notes</u>	
02-20-2005	Examiner's search strategy and results	
10-15-2004	<u>Amendment - After Non-Final Rejection</u>	
10-15-2004	Claims	
10-15-2004	<u>Applicant Arguments or Remarks Made in an Amendment</u>	
07-15-2004	Non-Final Rejection	
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07-15-2004	<u>classification, databases and other search related notes</u>
07-12-2004	<u>Examiner's search strategy and results</u>
07-11-2004	<u>Examiner's search strategy and results</u>
10-30-2003	<u>Information Disclosure Statement (IDS) Filed</u>
10-30-2003	<u>Foreign Reference</u>
10-30-2003	<u>Foreign Reference</u>
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10-30-2003	<u>Foreign Reference</u>
10-30-2003	<u>NPL Documents</u>
05-03-2001	<u>Fee Worksheet (PTO-875)</u>
05-03-2001	<u>Fee Worksheet (PTO-875)</u>
05-03-2001	<u>Claims Worksheet (PTO-2022)</u>
05-03-2001	<u>Foreign Priority Papers Filed</u>
05-03-2001	<u>Transmittal letter</u>
05-03-2001	<u>Specification</u>
05-03-2001	<u>Claims</u>
05-03-2001	<u>Abstract</u>
05-03-2001	<u>Drawings</u>
05-03-2001	<u>Oath or Declaration filed</u>

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